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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,465	04/24/2001	Seth Haberman	2000522.125 US2	5373

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WILMERHALE/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

EXAMINER	
VAN HANDEL, MICHAEL P	
ART UNIT	PAPER NUMBER
2623	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/841,465	HABERMAN ET AL.	
	Examiner	Art Unit	
	Michael Van Handel	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 10/31/2007. Claims **1-19** are pending. Claims **1**, **16**, and **19** are amended. Claims **20**, **21** are canceled. The examiner hereby withdraws the rejection of claims **1-18**, **21** under 35 USC 112, first paragraph in light of the amendment.

Response to Arguments

1. Applicant's arguments regarding claims **1**, **16**, and **19**, filed 10/31/2007, have been fully considered, but they are not persuasive.

Regarding claims **1**, **16**, and **19**, the applicant argues that Klosterman et al. does not show or suggest inserting different media segments into the media slots of a personalized advertisement template, where each of the media segments is one of an audio segment, a video segment, a graphic segment, a rendering segment, and a segment of last minute information. The examiner respectfully disagrees. As noted in the Office Action mailed 9/17/2007, Klosterman et

al. discloses systems and methods for allowing a network to set up multiple channels of advertising, e.g., FOX, FOX1, FOX2, etc. Each channel provides a separate program of advertising synchronized in time to coincide with advertising delivered on the main channel, e.g., FOX. For example, the television set of an individual viewer who is watching the SuperBowl on FOX will be automatically tuned, in a manner invisible to the viewer, to one of the multiple FOX channels during a commercial break (p. 2, paragraph 31). Klosterman et al. further discloses that a television set automatically tunes in a serial manner to one or more of the multiple FOX channels (p. 2, paragraph 31). The examiner interprets this as a plurality of different media segments that are insertable into at least one of a plurality of slots in sequence. The examiner further notes that a main television channel with a main program and advertisements is inherently an advertisement template comprising a plurality of slots in sequence, as currently claimed. As such, the examiner maintains that Klosterman et al. meets the limitation of "creating a personalized advertisement template comprising a plurality of media slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots," as currently claimed. Klosterman et al. further discloses that the substituted content could be video and/or audio and/or graphics and/or text (p. 1, paragraph 10 & p. 5, 6, paragraphs 63, 68). This meets the limitation of "wherein each of the plurality of different media segments is one of: an audio segment, a video segment, a graphics segment, a rendering segment, and a segment of last minute information," as currently claimed.

Further regarding claims **1**, **16**, and **19**, the applicant argues that each channel of advertising is not delivering a different one of said plurality of media segments for insertion in to the media slots, as required by the independent claims. The examiner respectfully disagrees.

Klosterman et al. discloses that each of the multiple channels of advertising (e.g., FOX, FOX, FOX2, etc.) provides a *separate* program of advertising synchronized in time to coincide with advertising delivered on the main channel, e.g., FOX (italicized for emphasis). The television set automatically tunes in a serial manner to one or more of the multiple FOX channels (p. 2, paragraph 31). Since each of the multiple channels of advertising provides a separate program of advertising, the examiner interprets the advertising on these channels to be different, as currently claimed.

Still further regarding claims **1**, **16**, and **19**, the applicant argues that Klosterman et al. fails to show or suggest a system that uses said content selection information to switch between said plurality of data streams to retrieve at least one of said media segments for each of said slots, to generate a customized broadcast transmission stream, thereby assembling a personalized advertisement. The applicant specifically argues that Klosterman et al. describes a system for switching between complete commercials sent over multiple channels, to allow different commercials to be displayed to a viewer, but does not retrieve different media segments for insertion into the personalized advertisement template to generate a customized broadcast transmission stream. The examiner respectfully disagrees. As noted above, the main television channel with the main program and switchable advertisement slots is inherently an advertisement template comprising a plurality of slots in sequence, as currently claimed. The examiner interprets switching to different commercials within a commercial break as generating a customized broadcast transmission stream. As such, the examiner maintains that Klosterman et al. meets the limitation of switching "between said plurality of data streams to retrieve at least

one of said media segments for each of said slots, to generate a customized broadcast transmission stream," as currently claimed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-5**, **8**, **9**, **12**, **13**, **15**, **16**, **18**, and **19** are rejected under 35 U.S.C. 102(e) as being anticipated by Klosterman et al.

Referring to claims **1**, **16**, and **19**, Klosterman et al. discloses a method/system for allowing the creation of a plurality of personalized advertisements to be viewed by an intended audience, comprising:

- creating a personalized advertisement template comprising a plurality of media slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots and wherein each of the plurality of different media segments is one of: an audio segment, a video segment, a graphics segment, a rendering segment, and a segment of last minute information (p. 1, paragraph 10; p. 3, paragraphs 38-40, 42, 44, 45, 48; & p. 5, 6, paragraphs 63, 68);

- simultaneously transmitting a plurality of data streams to a receiving unit, each data stream delivering a different one of said plurality of media segments for said at least one of said slots, wherein said media segments are synchronized to begin and end at substantially the same time (p. 2, paragraph 31 & p. 3, paragraph 39); and
- transmitting content selection information regarding content of said plurality of data streams to said receiving unit, said information including switch times for said plurality of synchronized media segments, wherein said receiving unit uses said content selection information to switch between said plurality of data streams to retrieve at least one of said media segments for each of said slots, (p. 2, paragraphs 32, 33; p. 3, paragraphs 38-40, 42; & p. 4, paragraphs 44, 45, 48), to generate a customized broadcast transmission stream, thereby assembling a personalized advertisement (p. 6, paragraph 71).

Further referring to claims **16** and **19**, Klosterman et al. discloses that one of said data streams transmits content selection information regarding content of said plurality of data streams said information including switch times for allowing a receiving unit to switch among said plurality of data streams to select a particular media segment at a particular time (p. 3, paragraphs 38, 39), to assemble a personalized advertisement (p. 6, paragraph 71).

NOTE: The USPTO considers the applicant's "one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim **2**, Klosterman et al. discloses the method of claim 1, wherein said receiving unit selects among said plurality of data streams in real time (Klosterman et al. discloses automatically tuning the television set of an individual viewer to one of multiple FOX

channels of advertising during a commercial break, in a manner invisible to the viewer. The examiner interprets this as selecting among the plurality of channels in real time)(p. 2, paragraph 31 & p. 4, paragraphs 44, 45).

Referring to claim **3**, Klosterman et al. discloses the method of claim 1, wherein said personalized advertisement is viewed by a viewer as it is assembled (p. 6, paragraph 71).

Referring to claim **4**, Klosterman et al. discloses the method of claim 1, wherein said receiving unit selects among said plurality of data streams based on said content selection information and information about a viewer who will view said personalized advertisement (p. 3, paragraph 40).

Referring to claim **5**, Klosterman et al. discloses the method of claim 4, further including providing a data stream with a default personalized advertisement to allow said receiving unit to display said default personalized advertisement without selecting between said plurality of data streams (the examiner notes that in the SuperBowl example, the beer commercial is the commercial displayed on Channel A with the SuperBowl program. Thus, the examiner interprets the beer commercial to be a default personalized advertisement, as claimed)(p. 4, paragraphs 44, 45).

Referring to claim **8**, Klosterman et al. discloses the method of claim 1, wherein said segments are incomplete parts of a personalized advertisement (the examiner notes that Klosterman et al. discloses preloading advertisement overlay messages into the memories of a viewers' television system. When the advertisement is broadcast, the overlay message is displayed with it. The examiner interprets these advertisements to be incomplete sections of a complete non-interactive advertisement, as claimed (p. 6, paragraph 71).

Referring to claim **9**, Klosterman et al. discloses the method of claim 1, wherein said receiving unit is a set top box (p. 3, paragraph 35).

Referring to claims **12** and **18**, Klosterman et al. discloses the method/system of claims 9 and 16, respectively, wherein said set top box momentarily switches from a first digital data stream to a second digital data stream to play out a personalized advertisement (p. 2, paragraph 31 & p. 3, paragraphs 35, 40).

Referring to claim **13**, Klosterman et al. discloses the method of claim 9, wherein said set top box receives a plurality of television channels over said data streams, and said channels include programs including a synchronized commercial break; and during said synchronized commercial break, said data streams deliver segments to create a personalized advertisement for display irrespective of which channel said set top box had selected (p. 2, paragraph 31; p. 3, paragraphs 38-40, 42; & p. 4, paragraphs 44, 45).

Referring to claim **15**, Klosterman et al. discloses the method of claim 1, further including a plurality of templates for creating said personalized advertisements, wherein said templates include video sequence templates and audio sequence templates (the examiner notes that each channel shows a series of advertisements back-to-back. These advertisements include video and audio. Since these advertisements can be modified by adding overlays to create a more personalized advertisement, the examiner interprets the original channel advertisements to be have video sequence templates and audio sequence templates that are used with the overlay messages to create more personalized advertisements)(p. 2, paragraph 31; p. 3, paragraphs 38-40, 42; p. 4, paragraphs 44, 45; & p. 6, paragraph 71).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim **6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al. in view of Ten Kate et al.

Referring to claim **6**, Klosterman et al. discloses the method of claim 1. Klosterman et al. does not disclose that the plurality of data streams are MPEG encoded data streams. Ten Kate et al. discloses encoding video streams in MPEG-2 (col. 3, l. 39-41, 61-67). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the channels of Klosterman et al. to be MPEG encoded, such as that taught by Ten Kate et al. in order to achieve a higher compression rate.

3. Claims **7**, **10**, **11**, **17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al. in view of Picco et al.

Referring to claim **7**, Klosterman et al. discloses the method of claim 1. Klosterman et al. does not disclose that the plurality of data streams are multiplexed into a transport stream. Picco et al. discloses multiplexing live television feeds 106, local content streams 108 and various other signals into a digital data stream that is then transmitted to a user (col. 8, l. 56-67 & Fig. 5). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the channels of Klosterman et al. to be multiplexed into a digital data stream,

such as that taught by Picco et al. in order to provide individualized local content in a digital stream by transmitting to the user a single multiplexed data stream (Picco et al. col. 2, l. 42-44).

Referring to claims **10**, **11**, and **17**, Klosterman et al. discloses the method/system of claims 9 and 16. Klosterman et al. further discloses that the invention can receive analog television and digital television (p. 3, paragraph 35). Klosterman et al. still further discloses switching advertisements in response to a channel change command in the vertical blanking interval (VBI) (p. 3, paragraph 38). Klosterman et al. does not disclose that the set top box momentarily switches from an analog data stream to a digital data stream to play out a personalized advertisement triggered by VBI data. Picco et al. discloses a set top box 120 (Fig. 7) that can receive both analog data streams and digital data streams (col. 14, l. 62-67). Picco et al. further discloses that the set top box 120 activates a web browser in response to a user selection when the user sees a television advertisement, which references a particular web site (col. 14, l. 17-41 & Fig. 11). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the VBI triggered advertisement switching of Klosterman et al. to include switching from an analog stream to a digital stream to display advertising information, such as that taught by Picco et al. in order to provide a television viewer with advertising from the Internet.

4. Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al. in view of Kunkel et al.

Referring to claim **14**, Klosterman et al. discloses the method of claim 1. Klosterman et al. does not disclose including transition segments, which are inserted into a personalized

advertisement between segments. Kunkel et al. discloses encoding video streams in MPEG1 or MPEG2. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the channels of Klosterman et al. to be MPEG encoded, such as that taught by Kunkel et al. in order to achieve a higher compression rate. Kunkel et al. further discloses sending I-frames continuously at the beginning of targeted ads, so that the set top box tuners can quickly acquire the signal. Similarly, a continuous stream of I-frames is provided for the last few seconds of the advertisement to enable the tuners to quickly reacquire the original channel once the advertisement has concluded (p. 4, paragraph 31). It would have been obvious one of ordinary skill in the art at the time that the invention was made to modify the combination of Klosterman et al. and Kunkel et al. to include continuously sending I-frames at the beginning and end of advertisements, such as that taught by Kunkel et al. in order to facilitate seamless transitions between advertisements and original programming (Kunkel et al. p. 4, paragraph 31).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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